

REMARKS

Claims 1-32 have been cancelled without prejudice, and claims 33-77 have been added. No new matter has been added by virtue of the new claims. Support for the new claims appears e.g. at page 5, line 25 through page 6, line 2 and the original claims of the application.

Claims 4-22 and 29-32 were objected to under 37 CFR 1.75(c) as having improper multiple dependency (non-substantive matter of form).

The new claims do not have such multiple dependency.

Claims 1-3 and 23-27 were rejected under 35 U.S.C. 102 over Sato et al. (U.S. Patent 5,736,296).

Claim 28 was rejected under 35 U.S.C. 103 over Sato et al. (U.S. Patent 5,736,296).

Claims 1-3 were rejected under 35 U.S.C. 102 over Carpenter et al. (U.S. Patent 5,498,765).

For the sake of brevity, the three rejections are addressed in combination. Each rejection is traversed.

The pending claims call for a photoresist that comprises 1) a resin, 2) a photoacid generator compound, and 3) lactic acid or acetic acid.

The cited documents do not disclose or otherwise suggest such photoresist compositions. Among other things, the cited documents do not disclose photoresists that contain lactic acid or acetic acid.

Moreover, the application as filed includes comparative results that show use of a photoresist with acid as claimed provides enhanced performance, particularly enhanced storage stability. See the results of Examples 1-4 (pages 16-20 of the application), and where in comparative Example 4 inferior storage stability was exhibited.

In view thereof, reconsideration and withdrawal of the rejections are requested. See, for instance, *In re Marshall*, 198 USPQ at 346 ("[r]ejections under 35 USC 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art."). See also Section 2143.03 of the Manual of Patent Examining Procedure ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.").

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter F. Corless', is written over a horizontal line.

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